UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,181	09/24/2001	Takuro Ikeda	1405.1050	7175

21171   7590   09/15/2008
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER
CASLER, TRACI

ART UNIT	PAPER NUMBER
3629	

MAIL DATE	DELIVERY MODE
09/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 June 2008_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1,2 and 4-11_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1, 2, 4-11_ is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

DETAILED ACTION

This action is in response to papers filed on June 23, 2008.

Claims 1, 2, 9 and 10 have been amended.

Claim 3 has been cancelled.

Claims 1, 2, 4-11 are pending.

Claims 1, 2, 4-11 are rejected.

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set

forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

February 27, 2008 has been entered.

Claim Rejections - 35 USC § 112

2.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

3.   Claims 1, 2, 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

4.   The claims are directed to a step of "assigning correspondence" between both a

"dialog scenario and a destination address" as well as between "customer-identifying

data and customer information." As currently claimed it is unclear as to whether it is the

same "correspondence" that is being assigned to both as well as what exactly is a

"correspondence". The applicant makes statements in response dated June 23, 2008

(Pg. 1 ¶ 2 *Applicants respectfully submit that the use of the term "assigning*

correspondences in the specification in conjunction with the figures and additional

description therein, reasonably puts on notice a person of ordinary skill in the art about

the intended meaning, which is not contrary to its ordinary meaning)that lead the

examiner to believe that the applicant is intending to be their own "lexicographer" for

this term, however, where applicant acts as his or her own lexicographer to **specifically**

define a term of a claim contrary to its ordinary meaning, the written description

must clearly redefine the claim term and set forth the uncommon definition so as

to put one reasonably skilled in the art on notice that the applicant intended to so

redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350,

1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). It is unclear as to the examiner as to

what the applicant intends this term to mean and how it differs from the ordinary

meaning of correspondence as exchange communication. The term is indefinite

because the specification does not clearly redefine the term. The applicant identifies

Fig. 2 and 3 for explaining how "assigning correspondences" takes place. However,

these figures and their related text in the disclosure do not mention "assigning

correspondences", with the exception of one excerpt "the scenario DB 302 assigns

correspondences between stores Merchandise Name, Dialogue Scenario Name and log

send destination." This does not clarify what the correspondences are that are being

assigned.

5.   Furthermore, if applicant intends the ordinary meaning of exchanging communication, the examiner is unclear as to how it differs then from holding a dialogue scenario. If the ordinary meaning is not meant, then this would lead to questions of how exactly one would assign these correspondence without a clear definition of what is being assigned.

6.   Lastly, the examiner notes the limitations of "assigning correspondence" is considered non-functional descriptive material. A correspondence is assigned but nothing is further done with these correspondences in any of the proceeding limitations. Therefore, the correspondence has not function in the final outcome of the claim.

Claim Rejections - 35 USC § 101

7.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8.   As to claim 1 it is directed towards non-statutory subject matter as the claims fail to 1) be tied to another statutory class(such as a particular apparatus) or 2) transform the underlying subject matter(such as article or materials). If neither of these requirements are met by the claim, the method is not a patent eligible process under 35 USC 101 and is non-statutory subject matter. The examiner further notes that a "nominal " tie to another statutory class, such as a computer limitation in the preamble, will not solve the deficiency.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

10.   Claims 1, 2, 4, 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable

over US Patent Publication 20020128898 Smith JR et al; Dynamically assigning a

survey to a respondent; in view of US Patent 6381744 Nanos et al; Automated Survey

Kiosk. Hereinafter referred to as Smith and Nanos respectively.

11.   As to claims 1, 2, 9 and 10 Smith Teaches a system, method and apparatus:

12.   storing dialogue scenarios; **(Pg. 6 ¶ & Pg 7 ¶ 115 client can develop and save**

multiple surveys(scenarios) the automated survey mechanism determines the

particular location where the survey will reside(store)

13.   assigning correspondences between each of the dialogue scenarios and one or

more destination addresses;(as best understood by examine)**(Pg. 10 ¶ 150-157**

associating surveys with target participation criteria)

14.   assigning correspondences between customer-identifying data and customer

information;(as best understood by examiner) **(Pg. 10 ¶ 153 participant request is**

used to determine screening questions).

15.   accepting input of the customer-identifying data; ;**(Pg. 8 ¶ 128 network user is**

required to enter certain pertinent information)

16.   extracting from the dialogue scenarios, a dialogue scenario to be performed **(Pg.**

9 ¶ 145 dynamically identify and select a particular survey that is to be provided

to respondent)

17.   holding a dialogue with a customer following the extracted dialogue scenario, the

customer being identified based on the customer-identifying data; **(Pg. 9 ¶ 156 the**

identified survey is forwarded to client to allow respondent to participate).

18.   acquiring dialogue content from the dialogue; extracting customer information

corresponding to the inputted customer-identifying data; associating the extracted

customer information with the dialogue content; transmitting the dialogue content and

the customer information to the one or more destination addresses corresponding to the

extracted dialogue scenario; **(Pg. 8 ¶ 132 results are process and analyzed to**

generate survey data…the extraction of survey data is sent to the address that

was previously specified by the client defining the survey).

19.   Smith fails to teach storing the dialogue content received at the one or more

destination addresses; and outputting the dialogue content at the one or more

destination addresses corresponding to the extracted dialogue scenario. However,

Nanos teaches the dialogue content stored at the destination and output at the

destination(C. 7 l. 63-67). It would have been obvious to one of ordinary skill in the art

the time of invention to combine Nanos destination storage and output with Smith's

survey process as the claimed invention is merely a combination of old elements and in

the combination each element merely would have performed the same function as it did

separately and one of ordinary skill in the art would have recognized that the results of

the combination were predictable. Additionally, be allowing the destination(or survey developer) maintain the information themselves this would allow them to use the data how they wished for presentations or further analysis.

20.   As to claim 4 Smith teaches a dialog storing unit(Pg. 6 ¶ 99; Pg. 7 ¶ 115)

21.   As to claim 7 Smith teaches billing the companies for developing or creating surveys(Pg. 7 ¶ 113).

22.   As to claims 8 and 11 Smith teaches compensation for the survey participant(Pg. 9 ¶ 139 Pg. 8 ¶127).

23.   Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith/Nanos as applied to claims 1, 2, 4, 7-11 above, and further in view of US Patent Publication 20020091569 Kitaura et al; Electronic coupon system, hereinafter referred to as Kitaura.

24.   As to claims 5-6 Smith/Nanos fail to teach the following limiations; however Kitaura teaches:

25.   further comprising a merchandise-specifying unit accepting input of merchandise identification data for identifying merchandise,(Pg. 3 ¶ 24 users entering product identification information)

26.   wherein said scenario storage unit correspondingly assigns merchandise identification data to each of the dialogue scenarios, and stores as the destination addresses, communications addresses for providers of the merchandise identified by the merchandise identification data; wherein said extraction unit extracts the dialogue scenario corresponding to input merchandise identification data; and wherein said

information transmission unit transmits the dialogue content to the communications

addresses corresponding to the merchandise identification data (Pg. 9 L 137-

139conducts survey using usage information surveys for manufactures on persons who

purchased certain products and reports results to manufacture).

Response to Arguments

27.   Applicant's arguments with respect to claims 1, 2, 4-11 have been considered but

are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Traci L. Casler whose telephone number is 571-272-

6809. The examiner can normally be reached on Monday-Thursday 6:00 am-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Traci L Casler/
Primary Examiner, Art Unit 3629